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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/372,966	08/12/99	KIKUCHI T	B-3425-DIV-6

QM32/0626

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EXAMINER	
NGO, L	
ART UNIT	PAPER NUMBER
3731	7

DATE MAILED: 06/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/372,966	Kikuchi et al.
Examiner	**Group Art Unit**
Lien Ngo	3731

☒ Responsive to communication(s) filed on *3-28-00*.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-32* is/are pending in the application.

Of the above, claim(s) *1-3 and 8-16* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *4-7 and 17-32* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

An anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claims are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. See, for example, Standard Havens Products Inc. v. Gencor Industries Inc., 953 F.2d 1360, 21 USPQ2d 1321 (Fed. Cir. 1991).

2. Claims 4, 5, 7, 22, 26, 27, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima et al. (5,496.328).

In regard to claims 4 and 7, Nakajima et al. disclose, in figure 1, an insertion device for inserting into the eye a deformable intraocular lens 1 having an optical part 2 which is made of and elastic material and which has predetermined memory characteristics, and a supporting portion 3 which is made of a different from that of the optical part, as disclosed in fig. 4 and col. 3, lines 32-37. Said insertion device comprises an enclosing member 24, which has a hinge portion 29, for holding said lens in advance, and a holder 37 for closing said enclosing member and maintaining the closed state.

In regard to claim 5, said deformable intraocular lens has a peripheral edge portion of the lens is an outer circumferential edge of the optical portion of the lens, as seen in figure 4.

In regard to claim 22, said enclosing member having said hinge portion and said holder are integrally build in a body of the insertion device, as seen in figure 2.

In regard to claims 26, 27, 30, said enclosing member is transparent , as disclosed in column 6, lines 47-61, and said holder has an opening 23 serving as an observation window, as seen in figure 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one of ordinary skill in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA) 1975. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

4. Claims 6, 19, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al. in view of Eagles et al.(5,616,148). Nakajima et al. disclose the invention substantially as claimed except they do not disclose the enclosing member is separated form a body of the insertion device, or the holder is an independent part, or the enclosing member and the holder are integrated together and are separated from the body. Eagles et al. teach, in column 4, lines 9-42, the three components, an enclosing member (lens cartridge), a holder (lens cartridge receiver), and a body (nozzle portion), could be separated or connected together when assembled in various manners. It would have been an obvious matter of design choice for the connection

some or all of the said components for a desired assembling or a purposed separating of a insertion device for a deformable intraocular lens..

5. Claims 17, 18, 20, 21, 28, 29, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al. in view of Eagles et al.. Nakajima et al. disclose the invention substantially as claim except they do not disclose the enclosing member comprising grooves on the inner surface having converging portions formed at front and rear sides of said grooves. Eagles et al. teach, in figure 11, grooves 22e on inner surface of an enclosing member having converging portions which are formed at front and rear sides of said groove for receiving and holding a deformable intraocular lens.

Therefore, it would have obvious to one having ordinary skill in the art at the same time the invention was made, in view of Eagles et al., to modify the insertion device for a deformable intraocular lens of Nakajima et al. having grooves for receive and holding said lens which has converging portions formed at front and rear sides of said grooves in order to stabilize the position of said lens on the enclosing member.

Response to Arguments

6. Claims 4-7 have been withdrawn from Double Patenting Rejecton in the previous Office Action , Paper No. 4.

Claims 17 and 18 have been withdrawn from Allowable subject matter in the previous Office Action, Paper No.4, beause they claim the same subject matter in the original claims 17 and 18 of the Patent application 09/ 032, 211, which have been rejected under 35 U.S.C. 103 (a) as being unpatenable over Nakajima et al. in view of Eagles et al.. in paper No. 4 of the application 09/032,211.

Conclusion

7. This is a DIV of applicant's earlier Application No. 09/032211. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however,

event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Ngo whose telephone number is (703) 305-0294. The examiner can normally be reached Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, Michael Buiz, can be reached at (703)308-0871. The Group FAX number is (703) 305-3590.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 308-0858.

Lien Ngo

MICHAEL BUIZ
SUPERVISORY PATENT EXAMINER
GROUP 3300
6/16/00

June 16, 2000